

ATTORNEY DOCKET NO: 82223-202

EXAMINER Shengjun Wang
ART GROUP 1617
APPLICANT Lorraine Mignault
SERIAL NO: 09/762,232
FILED August 4, 1999
FOR Topical Lotion Containing Oatstraw

Commissioner of Patents
Washington, D.C., 20231
U.S.A.

Dear Sir:

Responsive to the Notice of Non-Compliant Appeal Brief, a replacement appeal brief is attached hereto wherein:

The titles of the sections have been changed so as to be consistent with 37 CFR 41.37;

A concise statement of the ground of rejection has been added to Section 6.

Subheadings have been added to Section 7 which lists the headings for each individual argument.

The claims appendix has been moved into the document (section 8).


Sections 9 and 10 have been added.

No other amendments have been made.

We hereby authorize you to charge the fee for a two month extension in time as per 1.17(a)(2) (small entity) of \$225 to our Deposit Account No: 01-0310. In the event that any additional fees are required, you are hereby authorized to charge or credit any additional fees to our deposit account 01-0310.

Respectfully submitted

LORRAINE MIGNAULT

PER: 
Michael R. Williams
Registration No: 45,333



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APPEAL BRIEF

The following Appeal Brief is presented in Appeal of the Final Rejection of the Examiner dated November 17, 2004 and the Advisory Action before the Filing of an Appeal Brief dated March 9, 2005 and subsequent to the Notice of Appeal filed May 11th, 2005. This Appeal Brief sets out all of the requirements under 37CFR 1.192(c) as follows:

1. Real Party of Interest

The party of interest is the applicant as set forth above.

2. Related appeals and interferences

There are no related appeals and interferences.

3. Status of Claims

Claims 1, 2, 5-9, 17-22 and 24-30 are present in this application and all claims are rejected and are the subject of this Appeal.

4. Status of Amendments

Subsequent to the issue of the Final Rejection, a further response was filed which contained no amendments to the claims. It is therefore believed that there are no unentered amendments so that the claims presented herein are as set for the hereinafter.

5. Summary of Claimed Subject Matter

It is believed to be simplest to define a summary of the invention in terms of the claims as follows:

The invention relates to an oatstraw extract and methods of preparation and use of same.

The invention involves steeping the oatstraw in heated water.

The above features are well known to anyone skilled in the art and the following features distinguish the invention from the prior art:

Specifically, an oatstraw extract is prepared by:

magnetically treating water (page 7, lines 7-8),

heating the magnetically treated water,

steeping oatstraw in the heated water and

filtering the steeped oatstraw to remove oatstraw particles (page 7, lines 15-17).

Removal of the oatstraw particles from the steeped oatstraw is not explicitly taught by the prior art. This feature distinguishes the invention from the prior art in that the removal of the oatstraw particles allows the extract to be used as a topical lotion and as an additive in other products, thereby improving the properties of these products.

The invention is further distinguished from the prior art by the preparation of the oatstraw extract in magnetically treated or magnetized water. The combination of oatstraw extract in magnetically treated water has surprising properties, for example, improved efficacy of application, absorption and feel compared to extracts prepared in tap water or deionized water.

6. Grounds of Rejection to be Reviewed

Whether Claims 1, 5-9, 17-20, 22, 24-26 and 30 are unpatentable under 35 U.S.C. 103 over the prior cited patents of Weed in view of Puchalski, Jr. et al. and Jakobson et al., in further view of Ito, or Patrasenko et al.

The Examiner concluded that while "Weed does not expressly teach to

make water extract of oatstraw as herein claimed, or the addition of glycerin and lavender oil", Puchalski teaches a polyol to enhance skin feel and Jakobson teaches the addition of lavender oil. Regarding "magnetically treated water", the Examiner has stated that "the employment of magnetically treated water for preparing therapeutical composition would have been obvious in view of Ito or Patrasenko [which] teach magnetic treatment provide cleaner water".

It is believed that the rejection under 35 USC 103 should be reversed for the following reasons:

1) There is no incentive to combine the cited references, as discussed above. Specifically, there is no indication in the combination of references of the desirability of preparing an aqueous oatstraw extract in magnetically treated water or the improved absorptive properties thereof.

2) As discussed above, even if combined, the cited art does not lead to applicant's invention.

3) The examiner's analysis of Weed is contrary to MPEP 2141 (B) and (C) in that the examiner is not considering the reference in its entirety and is also reading the reference in hindsight.

4) No references have been cited which teach or suggest filtering of an aqueous oatstraw suspension.

5) The submitted affidavits regarding the surprising properties of an oatstraw extract in magnetically treated water have not been given sufficient weight, contrary to MPEP 716.02 (b) and MPEP 716.01 (c).

6) Contrary to MPEP 2144, the use of magnetically treated water as a feature of the claims has not been properly considered.

Grouping of Claims

The Applicant presents the following groups of claims for consideration:

Group 1---Claims 1, 5, 6 and 7. It is accepted that Claims 5, 6 and 7 will stand or fall with Claim 1.

Group 2---Claims 8, 9 and 24. It is accepted that claims 9 and 24 will stand or fall with Claim 8.

Group 3---Claim 17.

Group 4---Claims 18 and 19. It is accepted that claim 19 will stand or fall with claim 18.

Group 5---Claims 20 and 22. It is accepted that claim 22 will stand or fall with Claim 20.

Group 6---Claim 25.

Group 7---Claims 26 and 30. It is accepted that claim 30 will stand or fall with claim 26.

7. Argument

In the Advisory Action dated March 9, 2005 and the Final Action dated November 17, 2004, the Examiner has set out his position concerning the rejections of Claims 1, 5-9, 17-20, 22, 24-26 and 30. Specifically, these claims were rejected under 35 USC 103(a) over Weed in view of Puchalski, Jr. and Jakobson, in further view of Ito or Patrasenko.

DISCUSSION OF PRIOR ART

Applicant notes that Weed teaches a plurality of uses for oatstraw, one of which is the addition of dried oatstraw or pulverized oatstraw directly to bath water in which the body part(s) to be soaked are then immersed. Weed is emphatic regarding the presence of the oatstraw within this bath, stating that the bath must contain "the oats and all" (Weed, page 205). Thus, Weed teaches that the beneficial properties of solubilized oatstraw, that is, of an oatstraw suspension, are short-lived and that the oats must be present within the water in order for benefits to be enjoyed. Weed does not teach or suggest that other compounds may be added to the oatstraw suspension or that the oatstraw may be mixed with other compounds. Weed also does not teach or suggest adding oatstraw to bath or shower products.

The examiner has previously taken the position that the most relevant sections of Weed to applicant's invention are as follows:

On page 200, Weed describes the preparation of an infusion: "*oatmeal*

made into a cake with water, baked and browned like coffee, then pulverized and made into a coffee or infusion". The pulverized infusion is strained to remove large particles.

On page 205, Weed teaches soaking feet in "strained oatstraw infusion" or soaking in a bathtub prepared by *"boil[ing] water and pour[ing] over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all.)"*

Puchalski teaches a shampoo and bath or shower gel composed of several different components, which may include a humectant and/or emollient, which **may** be glycerine (US Patent 4,690,818, column 2, lines 37-45).

Jakobson teaches a polyglycerol fatty acid ester mixture for use as a bath additive which **may** include lavender oil (US Patent 5,397,497, column 5, lines 11-21) which is listed as one of a number of oils having therapeutic or medicinal properties.

Ito teaches a method of preventing "red rust", scale and slime from forming on the inner wall of a pipe (US Patent 5,055,189, column 3, lines 45-50) wherein the method comprises subjecting the water in the pipe to far IR and magnets. Thus, Ito teaches a method for having cleaner pipes as minerals and the like are more readily dissolved or remain in solution in the magnetically treated water and are therefore prevented from precipitating out of solution and onto the walls of the pipes. That is, the magnetization of the water improves the ability of the water to retain solutes such as minerals. Furthermore, one would expect that the tap water exiting the pipes as taught by Ito would be saturated with minerals as the object of the method is to clean the pipes, not to improve the quality of the water and related properties.

Patrasenko teaches a water purification system wherein incoming water is subjected to a magnetic field and is then cooled and aerated prior to flocculation and settling. The water is then filtered to remove iron oxides, nitrates, heavy metals, residual chlorine and organic compounds. Patrasenko states that "the prepared water corresponds to quality standards for drinking water and has curative-prophylactic properties, due to higher activity of oxygen and other gases dissolved in water". Thus, Patrasenko teaches a water purification system that also involves aeration of water to add oxygen, and flocculation of the water and subsequent settling and filtering to remove contaminants. This water is suitable for drinking.

35 USC 103(a) Rejection is Contrary to MPEP 2141 (B) and (C)

The Examiner admitted that "Weed does not expressly teach to make water extract of oatstraw as herein claimed, or the addition of glycerin and lavender oil" but concluded that Puchalski teaches a polyol to enhance skin feel and Jakobson teaches the addition of lavender oil. Regarding "magnetically treated water", the Examiner has stated that "the employment of magnetically treated water for preparing therapeutical composition would have been obvious in view of Ito or Patrasenko [which] teach magnetic treatment provide cleaner water".

Applicant has argued repeatedly that Weed teaches adding dried oatstraw or pulverized baked oatstraw directly to bath water in which the body part(s) to be soaked are then immersed. Weed does not teach or suggest that other compounds may be added or that the oatstraw suspension may be mixed with other compounds. Weed also does not teach or suggest adding oatstraw to bath or shower products. Puchalski teaches a long list of optional components which may be added to the shampoo and bath gel products, none of which is oatstraw. Jakobson teaches a polyglycerol fatty acid ester mixture to be added to a bath which does not list oatstraw as a potential additive. It is further noted that the products themselves are incompatible – Puchalski teaches a body wash product whereas Weed and Jakobson effectively teach bath additives, one of which is water soluble (Weed) and one of which is not (Jakobson) and that as discussed above there would therefore be no incentive to combine these references. That is, Puchalski teaches a different type of product from Weed and Jakobson, and the products taught by Weed and Jakobson are themselves incompatible, one being water soluble (Weed) and the other being water insoluble (Jakobson). Furthermore, even if one of skill in the art did combine these references, taking Weed and combining Jakobson and Puchalski therewith one of skill in the art could have selected any one of the six other emollients suggested by Puchalski and any one of the sixteen other oils listed by Jakobson and not produced applicant's invention. Thus, it is applicant's opinion that there is no incentive to combine Weed, Jakobson and Puchalski because each describes an incompatible product and Weed offers no teaching that oatstraw should be combined with other body cleansing agents. Furthermore, both Puchalski and Jakobson provide lengthy lists of optional additives and offer no teaching that specifically glycerine or lavender respectively are of particular usefulness or desirability.

Furthermore, neither Patrasenko or Ito teaches or suggests that an oatstraw extract prepared in magnetically treated water would have improved properties. Furthermore, even taking into account Patrasenko's comments regarding "curative-prophylactic properties", it is important to note that those relate to drinking water, not water which is applied to the skin or to other products. At best, Patrasenko may argue that using water prepared as described therein in preparation of an oatstraw extract was "worth a try" but that there was no guarantee that an extract prepared this way would have different properties on the skin compared to an extract prepared in untreated water, and certainly no suggestion that an oatstraw extract prepared in magnetically treated water would have improved spreading and "feel" characteristics with no sticky residue, compared to similar extracts prepared with deionized water or tap water.

As discussed previously, combining Weed with either Ito or Patrasenko teaches adding oatstraw to bath water which may be magnetically treated to improve water flow rates (Ito) or bath water which has been magnetically treated, oxygenated, flocculated, settled and filtered. Furthermore, the magnetized water taught by Ito would likely be saturated with minerals absorbed by the magnetically treated water while preventing scaling in the pipes and therefore on entering the bath tub, would likely not have a noticeable effect on the oatstraw suspension taught by Weed. It is also important to note that these references offer no suggestion to combine these teachings.

It is also noted that there must be incentive to combine references and the art must be considered as a whole. Specifically, no prior art has been cited which teaches or suggests that a filtered oatstraw extract would retain its properties compared to a suspension or that teaches or suggests that magnetically treated water would have improved rate and depth of absorption and "feel" properties when applied to the skin or that an oatstraw extract in magnetically treated water would lack the associated stickiness so that it could be used as an additive or carrier. That is, no references have been cited which teach filtering an aqueous oatstraw extract to remove oatstraw particles or that use of magnetically treated water would produce an oatstraw extract that absorbed more rapidly and more deeply into the skin and that also lacked the residual stickiness found with filtered extracts prepared in tap water or deionized water.

No references have been cited regarding the absorptive properties of magnetically treated water on skin. Thus, while the combination of the references cited by the examiner does not teach applicant's invention as discussed above, it is also clear that there is no incentive in the prior art to take the oatstraw soaking bath of Weed and use magnetically treated water instead of tap water. There is also no teaching or suggestion that so doing would eliminate the sticky residue left by the oatstraw bath taught by Weed or that the oatstraw particles of Weed could be removed from the soaking bath prior to use or that the oatstraw soaking bath could instead be bottled and used as a lotion, carrier or in combination with other products.

However, even if one of skill in the art were to combine the references, they teach preparing an oatstraw suspension in a tub of water, adding one of six emollients suggested by Puchalski, one of which may be glycerol, and adding any one of the sixteen oils listed by Jakobson, one of which may be lavender oil. If the user has followed the teachings of Ito to prevent scaling on incoming pipes, the bath water may be magnetically treated and contain minerals suspended therein. The user may also follow the teachings of Patrasenko and drink magnetically treated water while immersed in the oatstraw suspension. This is not applicant's invention. Applicant's invention is an oatstraw extract that is prepared by: magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw to remove oatstraw particles.

Applicant's invention differs from Weed and from the combination of the cited prior art in several ways. Specifically:

- 1) Weed teaches an oatstraw suspension bath, not a topical lotion or additive.

- 2) Weed does not teach or suggest filtering an oatstraw suspension to prepare an oatstraw extract (and in fact teaches against filtering).

- 3) Weed does not teach or suggest the use of magnetized water. As discussed above, while Ito and Patrasenko do disclose benefits of magnetization to improving water flow (Ito) and as part of a water purification system (Patrasenko), they do not teach or suggest use of magnetized or magnetically treated water in combination with an oatstraw extract.

As will be appreciated, all three of these differences impact the invention and are connected. That is, once applicant discovered that the beneficial properties of the oatstraw are retained even in an oatstraw extract prepared by steeping the oatstraw in heated magnetically treated water and then removing the oatstraw residue, the opportunity to use the extract in other products was realized. The extract can be aliquoted for use as a topical lotion or can be added to other products. By removing the oatstraw residue, applicant has been able to produce an extract which can be applied to the skin or added to other products which would not be possible if the oatstraw extract was not filtered, as the oatstraw would leave an unpleasant residue or particles or clumps of oatstraw on the skin of the individual and the oatstraw would potentially interfere with other components within the other product.

35 USC 103(a) Rejection is Contrary to MPEP 2141.02 and MPEP 2141(C)

As discussed in a previously submitted declaration, in spring 2003, the inventor followed the teachings of Weed. Specifically, she added boiling water to dried oatstraw that had been chopped and then added that to a bathtub filled with warm water. What she found was that the chopped oatstraw stuck to her body and had to be physically removed or picked off. Furthermore, the free oatstraw clumps had to be scooped out of the bathtub during the draining process to prevent clogging of the drain. In addition, the water in the bathtub left a sticky residue on the body which could not be removed simply by wiping or drying with a towel and in fact required subsequent rinsing under a showerhead to remove the residue. That is, this residual stickiness in the bathwater was independent and separate from the oatstraw clumps. Similar results would be obtained using the teachings of Weed for any body part, for example, in a footbath. That is, the clumps of wet oatstraw adhere to the body, including the feet and must be physically removed and the water in the bath leaves a sticky residue on the body parts exposed thereto, which is separate and independent from the oatstraw clumps. Her experiences following Weed led her to conclude that anyone following Weed would find the experience time-consuming, frustrating and in fact irritating to the skin due to the added effort necessary to remove the oatstraw clumps and residue, as discussed above. Given the difficulties associated with the removal of the oatstraw clumps and associated residue from her body as well as from the inner surfaces of the

bathtub or waterbath, the inventor concluded that when Weed states "oats and all" she is saying to the reader "I know the oatstraw is messy, but it is necessary".

It is held that this declaration represents a comparison of the closest prior art with applicant's invention and that this declaration, which points out the limitations of Weed and also how one would interpret Weed as teaching away from filtering. It is held that this declaration has not been given proper weight by the examiner.

In the office action dated June 4, 2003, the examiner stated that Weed "teaches hot water extraction of oatstraw" and that "most of the active ingredients of oatstraw would have been extracted into water when 'extracted with boiling water'". The examiner has further stated that "using water extract only by filtering out the residues is an obvious alternative of keeping the residue in the water extract" and that "Weed does not teach against filtering. What Weed taught is a particularly situation, wherein the extract is made in situ".

Applicant informed the examiner that using the USPTO's definition of "extract", which requires that something be removed from the starting material, it is impossible to have an extract that is in its original form (i.e. in situ). Furthermore, Weed does not teach an extract because nothing is removed from the solution. It is also noted that in the most relevant example, Weed states that the oats are not to be removed. Thus, Weed does not teach an extract, Weed teaches a suspension. Weed teaches against filtering and does not teach or suggest that filtering would be beneficial or that one could expect filtering to produce a successful product. This is in contrast with applicant's invention, which is an oatstraw extract useful as a topical lotion or in other products.

It is further noted that the MPEP (2141) states that:

When applying 35 USC 103, the following tenets of patent law must be adhered to:

- (A) the claimed invention must be considered as a whole;
- (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) reasonable expectation of success is the standard with which obviousness is determined.

It is further noted that MPEP 2141.02 states that "a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention."

Applicant maintains that the examiner's statement on page 5 of the Office Action dated June 4, 2003 that "Weed provides no teaching or suggestion that the particular method disclosed therein is the only method to employ oatstraw. One of ordinary skill in the art would understand that oatstraw contains beneficial ingredients and would have been motivated to employ oatstraw in method other than those expressly disclosed by Weed" is in conflict with MPEP 2141, particularly points (B) and (C). Specifically, the fact that (in the examiner's opinion) Weed does not state emphatically that this is the only method does not and cannot mean that Weed therefore discloses all other methods of employing oatstraw, including those methods that Weed does not describe or suggest. That is, Weed does not teach or suggest filtering oatstraw for use on the skin; rather, the document is focused on uses of whole oatstraw.

Furthermore, the examiner appears to be admitting that Weed does not teach or suggest filtering an aqueous extract of oatstraw and using same as a topical lotion as described by applicant but is then concluding that this would have been obvious. The examiner however provided no sections in Weed nor any additional references supporting this position.

It is held that the examiner is clearly considering Weed in hindsight in view of applicant's disclosure and is not considering Weed in its entirety which is contrary to MPEP 2141.

This point was discussed with the examiner in October 2003 in a telephone interview. At that time, the examiner stated that the statement "Boil water and pour over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all.)" (Weed, page 205) was not a "strong statement" and implied that it was not a necessary step to include the oats in the tub.

This position is still not understood, as discussed herein. Weed states "yes, with the oats and all". There is nothing in that statement that implies that this is an

optional step or that there is a choice involved. Furthermore, Weed does not teach or imply filtering to remove the oatstraw residue from an aqueous extract for skin application. Filtering would be inconsistent with the teachings of Weed as a whole which is focused on the benefits of whole oatstraw. Applicant simply cannot understand how this can be considered anything but a "strong statement" and that on this basis Weed teaches against filtering.

Furthermore, applicant's representative has carried out a search of the case law and appeal decisions for the term "strong statement" and has not been able to locate other usage of this term or a definition thereof. As such, it is unclear exactly what the examiner would consider to be a strong statement as there does not appear to be a definition for same. Furthermore, even if this is held to not be a "strong statement", the fact remains that Weed does not teach, describe or suggest the desirability of filtering the aqueous oatstraw extract for soaking body parts and that filtering and/or extracts go against the teachings of Weed when taken as a whole, as discussed above. It is also noted that on at least two occasions (when arranging the telephone interview of October 6, 2003 and during the interview of October 6, 2003), the undersigned requested that the examiner discuss this situation with a superior. Both times, this request was rebuffed.

In summary, the examiner has provided no references that teach or suggest filtering an aqueous oatstraw extract. The examiner instead is relying on the Weed reference but contrary to MPEP 2141, is not considering the reference in its entirety and is reading the reference in hindsight. Specifically, the examiner is claiming that Weed does not teach against filtering and therefore must teach filtering or in the contrary that filtering would be obvious to one of skill in the art. As discussed above, the statement "oats and all" teaches against filtering and there is no statement that implies that filtering may be done. Furthermore, filtering would be inconsistent with the teachings of Weed as a whole which is focused on the benefits of whole oatstraw.

Thus Weed does not teach an extract: Weed teaches a suspension which must contain the oats. Weed does not teach a filtered oatstraw extract which is used as a topical lotion or as an additive: Weed teaches bath water containing oatstraw. Weed does not teach or suggest filtering the oatstraw solution but rather teaches that the

oatstraw must be left in the suspension in order for benefits to be obtained.

The examiner is maintaining an objection which is not supported by the cited art. Furthermore, the examiner is applying hindsight and the teachings of applicant's disclosure to the Weed reference and as a consequence inferring disclosure that is simply not present in Weed. It is further noted that the examiner has maintained that filtering an aqueous extract of oatstraw is obvious in view of prior art dealing with extracts of herbs and such but has not provided any references which specifically teach a filtered aqueous extract of oatstraw.

35 USC 103(a) Rejection is Contrary to MPEP 716.02 (a) and (b)

The invention is further distinguished from the prior art by the preparation of the oatstraw extract in magnetically treated or magnetized water. The combination of oatstraw extract in magnetically treated water has surprising properties compared to extracts prepared in tap water or deionized water.

As discussed in the submitted Declarations and responses, it is believed that the magnetic treatment of water increases the ability of the water to retain solutes, such as minerals or in applicant's case, compounds secreted from the oatstraw during the steeping process. Applicant notes that when water passes through a magnetic field, the hydrogen ions and dissolved minerals in the water become charged. This charge causes a temporary separation of these minerals and molecular water clusters resulting in water with increased clarity and softness, and reduced surface tension. In applicant's invention, this enhances the physical characteristics of the extract, such as conductivity, viscosity, softness and in turn facilitating ease of application, rate/depth of absorption and moisturization quality without leaving a film. A first benefit of this combination of oatstraw extract in magnetically treated water is that more of the beneficial compounds secreted by the oatstraw are retained in solution in the magnetically treated water. A second surprising benefit is that the oatstraw extract in magnetically treated water has greater rate and depth of absorption compared to comparable extracts prepared in either tap water or deionized water. A third surprising benefit is that the oatstraw extract in magnetically treated water lacks the residual stickiness found in the extracts prepared with either tap water or deionized water, as discussed in the Declaration and in the previously filed affidavits. It was this discovery that enabled the inventor to realize that

the extract could be added to other products and resulted in such products being produced.

It is respectfully believed that that the difficulties encountered regarding the use of magnetically treated water or magnetized water as a limitation are based in part on the failure of the examiner to consider the properties of magnetized water or magnetically treated water fairly and objectively.

In the office action dated November 26, 2002, the Examiner stated that he could "find no support in scientific literature that 'magnetized' water differs from 'water' in any way". Applicant responded by providing copies of articles on magnetization, including "Magnetic treatment of water: possible mechanisms and conditions for applications", by V. Kochmarsky, *Magnetic and Electrical Separation* 7: 77-107, 1996 and Johnson et al., 1998, *Journal of Clinical Periodontology* 25: 316-321, showing that the effects of magnetization on water were documented.

Despite this, in the office action dated June 4, 2003, the examiner stated that "the examiner has not been convinced that "magnetized water" and water would be any different for lacking of scientific evidence. The examiner fails to understand how the molecules of water, or their arrangement would be affected by magnet". An explanation of the magnetization process and its role in the instant invention similar to that above was provided in the response.

In a later office action, the examiner stated that "features upon which applicant relies (i.e., minerals in water) are not recited in the rejected claim(s)". This statement was not understood, because the mineral content of the water was not being claimed but rather that it was the ability of the magnetically treated water to retain more solutes that was important. Specifically, it is believed that magnetically treating water increases the ability of the water to retain solutes, whether these solutes are minerals in a pipe as taught by Ito or components of an aqueous oatstraw extract as taught by the inventor. As such, the mineral content of the water is not important as the magnetization of water which will increase the ability of the water to retain solutes compared to untreated water regardless of the mineral content of the water. It is also unclear exactly how the examiner came to the conclusion that the mineral content of the water was a feature upon which applicant was relying.

The examiner also rejected the arguments on the basis of the obviousness of using magnetically treated water as "cleaner" water. As noted above, it is not "cleaner" water per se that results in applicant's invention but the magnetic treatment which increases the ability of the water to retain components secreted by the oatstraw during steeping and also results in an extract having improved rate and depth of absorption and spreading properties as discussed previously.

Furthermore, in the office action dated November 17, 2004, the examiner stated that applicant had failed to argue against the combination of the references and that "the citing of Ito and Patrasenko is merely to show that magnetic treatment of water is well-known in the art and would have been obvious to one of skill in the art to use such process for a cleaner water". As discussed in the subsequent response, this objection was not understood because the examiner appeared to be objecting to the fact that applicant did not analyze references which were not cited. **It is also important to note that the examiner's opinion on the effect of magnetization on water had progressed from making no difference to being obvious.**

The idea that the benefits of magnetically treating water was controversial at best was also the initial position of Mr. Rick Green, whose affidavit was previously provided. As discussed in the inventor's affidavit, she expressed concern regarding the use of deionized water; however, she was told by the contractor (Mr. Rick Green) to expect "the same product results with either the deionized water or the magnetized water". As discussed in detail in paragraph 6 of the inventor's affidavit, that was not the case. Specifically, the samples prepared with deionized water were difficult to spread, slow to penetrate the skin and left a residual "stickiness" when applied to the skin. This is in contrast with the samples prepared with the magnetically treated water which was quick to absorb and left no residue.

It is again noted that deionized water is considered to be cleaner than tap water and that it was not the "cleanness" of the water that affected the properties of the extract but the magnetic treatment of the water that produced the improved extract as discussed in the previously provided affidavits.

It is noted that MPEP 716.02 (b) states that "evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention

with the closest prior art which is commensurate in scope with the claims”.

The examiner stated that the affidavits of the inventor and Rick Green submitted previously were not relevant because they were “directed at a distinction between deionized water and ‘magnetized’ water”.

It is held that these affidavits were not given proper consideration by the examiner. It is held that in accordance with MPEP 716.02 (b), the affidavits provide evidence of unexpected properties and that they represent at least an indirect comparison between applicant’s invention and the cited art but more importantly are commensurate in scope with the claims. That is, these affidavits show the effect of substitution of magnetically treated water for deionized water in applicant’s oatstraw extract.

35 USC 103(a) Rejection Contrary to MPEP 716.01(c)

It is also noted that the MPEP 716.01 (C) states that “some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him”. In this instance, the expert (Mr. Green) has stated that he believed that deionized water and magnetically treated water would produce an extract with the same properties and that he was wrong. It is further noted that in this instance, the expert has no interest in the outcome of this case.

35 USC 103(a) Rejection is contrary to MPEP 2144

It is noted that the examiner also stated numerous times that for examination purposes magnetized water was considered to be equivalent with tap water. Applicant noted that regular tap water is not used in cosmetic or pharmaceutical preparations and that deionized water is used, meaning that in this instance, the use of deionized water in the process described in the affidavits is proper, considering the extract is used as a topical lotion or additive.

It is also noted that on one hand the examiner is taking the position that magnetically treated water is equivalent to tap water for the examiner’s purposes but on the other hand that tap water is not equivalent to deionized water. It is further noted that as discussed above the literature contains support for differences between magnetized water and other types of water, for example, deionized water. It is of note that differences in conductivity and pH were noticed between deionized and magnetically

treated water as discussed in Mr. Green's affidavit. The affidavits also describe the differences observed when applicant's invention was prepared with deionized water instead of magnetically treated water.

Applicant notes that the MPEP 2144 states that "the examiner must apply the law consistently to each application after considering the relevant facts. If the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." In this case, the "prior legal decision" is the precedent at the USPTO regarding the patentability of magnetically treated fluids.

As discussed above, the claims state that the water is magnetically treated water. Applicant notes that several references describing the benefits of magnetically treating water have previously been provided and also notes that there is precedent at the USPTO regarding the patentability of magnetically treated fluids, such as US Patent 5,905,265 as well as devices for magnetically treating fluids, such as US Patent 5,500,121. Other patents relating to devices and methods for magnetically treating water or other fluids as well as patents which describe the utility of magnetically treated water include US Patent 6,250,118; US Patent 5,584,994; US Patent 6,171,490; US Patent 5,009,791; US Patent 4,946,560; US Patent 5,296,141; US Patent 5,500,121; US Patent 5,837,143; US Patent 5,866,010; US Patent 4,146,479; US Patent 4,299,700 and US Patent 4,422,933.

Thus, there is precedent at the Patent Office for allowing claims including magnetically treated fluids as limitations within the claims and also for devices for magnetically treating fluids such as water, clearly indicating that the Patent Office has previously recognized that magnetically treated water has unique and different properties. On this basis, it is believed that the claims including magnetically treated water should be approved. Furthermore, as discussed in the previously submitted declarations, the oatstraw extract prepared with magnetically treated water had improved properties compared to extracts prepared with deionized water, specifically, rate and depth of absorption and absence of residue to name a few. No references describing the desirability of preparing an aqueous extract of oatstraw or of combining same with magnetically treated water have been cited.

The Invention as Claimed

GROUP 1 – Claim 1

The number of features set forth in this claim are as follows:

Claim 1 describes a topical lotion for relieving pain, swelling or inflammation which comprises glycerine; lavender oil; and oatstraw extract, wherein the oatstraw extract is prepared by magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw to remove oatstraw particles.

As discussed above, there is no incentive to combine the cited references and even if combined, they do not teach applicant's invention. Specifically, no reference has been cited which teaches a filtered oatstraw extract prepared in magnetically treated water.

Group 2 – Claim 8

Claim 8 describes a method of treating pain, swelling, itching or inflammation wherein the above-described lotion is applied topically to inflamed, painful or swollen areas.

This claim is directed to one use of the lotion, for treatment of painful, inflamed or swollen areas. It is of note that the lotion is applied topically and does not require soaking in an oatstraw suspension as taught by Weed.

Group 3 – Claim 17

Claim 17 describes an additive comprised of at least 50% oatstraw extract, the oatstraw extract prepared by magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw to remove oatstraw particles, at least 25% glycerine, and 0.1-0.2% lavender oil and a suitable carrier.

This claim is directed to the use of the oatstraw extract as an additive which can be added to other products. As discussed above, filtering to remove the oatstraw residue makes it possible to add the extract to other products which is not taught or suggested by Weed or the cited prior art.

Group 4 – Claim 18

Claim 18 describes a hair or body product comprising: at least 50% oatstraw extract, the oatstraw extract prepared by magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw to remove oatstraw particles, at least 25% glycerine, and 0.1-0.2% lavender oil and a suitable carrier.

This claim is directed to a hair or body product containing the oatstraw extract. As discussed above, filtering to remove the oatstraw residue makes it possible to add the extract to other products which is not taught or suggested by Weed or the cited prior art.

Group 5 – Claim 20

Claim 20 describes a process for preparing an oatstraw extract comprising magnetically treating a quantity of water, heating the magnetically treated water, steeping a quantity of oatstraw in the heated water, thereby producing an oatstraw mixture and then filtering the mixture to remove the oatstraw, thereby producing an oatstraw extract.

This claim is similar in scope to claim 1 but is directed to the method of preparing the oatstraw extract. The same comments as re: group 1 apply.

Group 6 – Claim 25

Claim 25 describes a topical lotion for relieving pain, swelling or inflammation having an active ingredient consisting of oatstraw extract, the oatstraw extract is prepared by magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw to remove the oatstraw, wherein the lotion is applied topically to the skin of an individual in

need thereof.

This claim is directed to a method of preparing an oatstraw extract for treating pain, swelling or inflammation. The same comments as re: group 2 apply.

Group 7 – Claim 26

Claim 26 is directed to an additive having an active ingredient consisting of oatstraw extract, the oatstraw extract is prepared by magnetically treating water, heating the magnetically treated water, steeping oatstraw in the heated water and filtering the steeped oatstraw, wherein the additive is added to another product.

The same comments as re: group 3 apply.

In summary, it is believed that the rejection under 35 USC 103 should be reversed for the following reasons:

1) There is no incentive to combine the cited references as discussed above. Specifically, there is no indication in the combination of references of the desirability of preparing an aqueous oatstraw extract in magnetically treated water or the improved absorptive properties thereof.

2) As discussed above, even if combined, the cited art does not lead to applicant's invention.

3) The examiner's analysis of Weed is contrary to MPEP 2141 (B) and (C) in that the examiner is not considering the reference in its entirety and is also reading the reference in hindsight.

4) No references have been cited which teach or suggest filtering of an aqueous oatstraw suspension.

5) The submitted affidavits regarding the surprising properties of an oatstraw extract in magnetically treated water have not been given sufficient weight, contrary to MPEP 716.02 (b) and MPEP 716.01 (c).

6) Contrary to MPEP 2144, the use of magnetically treated water as a feature of the claims has not been properly considered.

8. Claims Appendix

1. (previously presented) A topical lotion for relieving pain, swelling or

inflammation comprising: glycerine; lavender oil; and the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles.

2. (previously cancelled)

3. (previously cancelled)

4. (previously cancelled)

5. (previously presented) The topical lotion according to claim 1 wherein the glycerine is vegetable glycerine.

6. (previously presented) The topical lotion according to claim 1 wherein the topical lotion consists essentially of:

at least 50% oatstraw extract;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%.

7. (previously presented) The topical lotion according to claim 1 wherein the topical lotion consists essentially of:

0.1% lavender oil;

25% vegetable glycerine; and

q.s. to 100% filtered oatstraw extract in magnetically treated water.

8. (previously presented) A method of treating pain, swelling, itching or inflammation comprising:

providing a topical lotion the lotion consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and

applying the lotion topically to inflamed, painful or swollen areas.

9. (original) The method according to claim 8 wherein the pain, swelling, itching or inflammation is caused by a condition selected from one of the following: psoriasis; skin poisoning from plants, shingles; measles; chicken pox; boils; sun damage; burns; sunburns; acne; eczema; rosacea; dermatitis; insect bites; herniated discs; back and/or leg spasms; sore or damaged muscles, ligaments and tendons; bruising; headaches; and arthritis.

10. (previously cancelled)

11. (previously cancelled)

12. (previously cancelled)

13. (previously cancelled)

14. (previously cancelled)

15. (previously cancelled)

16. (previously cancelled)

17. (previously presented) An additive comprising:

a mixture consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and

a suitable carrier.

18. (previously presented) A hair or body product comprising:

a mixture consisting essentially of:

at least 50% oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles;

at least 25% glycerine; and

0.1-0.2% lavender oil,

the sum of these three components being 100%; and
a suitable carrier.

19. (original) The body or hair product according to claim 18 selected from the group consisting of: body washes; shaving creams; shaving gels; shaving lotions; shampoos; conditioners; body lotions; moisturizing lotions; facial and wrinkle lotions; hand lotions; body creams; hand creams; facial creams; after-shave lotions; skin cleansing preparations; make-up removers; personal deodorants; suntan oil preparations; sunscreen preparations; sun block preparations; lip balms; aromatherapy products; massage gels; foot lotions; facial masques; pimple/acne preparations; facial and body firmers; pore size reducing preparations; styling lotions; and styling sprays.

20. (previously presented) A process for preparing an oatstraw extract comprising:

- providing a quantity of oatstraw;
- magnetically treating a quantity of water;
- heating the magnetically treated water;
- placing the oatstraw in the magnetically treated heated water;
- steeping the oatstraw in the magnetically treated heated water, thereby producing an oatstraw mixture; and
- filtering the oatstraw mixture, thereby producing an oatstraw extract.

21. (previously cancelled)

22. (previously presented) The process according to claim 20 wherein the topical lotion consists essentially of:

- at least 50% oatstraw extract;
- at least 25% glycerine; and
- 0.1-0.2% lavender oil,

the sum of these three components being 100%.

23. (previously cancelled)

24. (original) The method according to claim 8 wherein the pain, swelling, itching or inflammation is caused by a condition selected from one of the following: leprosy; cold sores; colds and flu; sinus congestion; menstrual bloating; menstrual cramps; foot pain; parasitic infections; varicose veins; fibromyalgia; multiple sclerosis;

cancer treatments; internal organ injuries; and brain and nerve surgery.

25. (previously presented) A topical lotion for relieving pain, swelling or inflammation comprising:

the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles,

wherein the lotion is applied topically to the skin of an individual in need thereof.

26. (previously presented) An additive comprising:

the active ingredient consisting of oatstraw extract, said oatstraw extract prepared by magnetically treating a quantity of water; heating the magnetically treated water; steeping oatstraw in the magnetically treated heated water and filtering the steeped oatstraw to remove oatstraw particles,

wherein the additive is added to another product.

27. (previously cancelled)

28. (previously cancelled)

29. (previously cancelled)

30. (previously presented) The additive according to claim 26 wherein the product is a cosmetic or pharmaceutical product.

9. Evidence Appendix

All documents referred to herein may be found in the prosecution file for this application.

10. Related Proceedings Appendix

There are no related proceedings.

It is requested therefore that the rejection under 35 USC 103 be reversed.

We hereby authorize you to charge the fee for filing this brief in support of an appeal \$250 to our Deposit Account No: 01-0310. In the event that any additional fees are required, you are hereby authorized to charge or credit any additional fees to our deposit account 01-0310.

Respectfully submitted

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PER: 

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